

## REMARKS

### **I.     Introduction**

Claims 1 to 8 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II.    Rejection of Claims 1 to 8 Under 35 U.S.C. § 103(a)**

Claims 1 to 8 were rejected as unpatentable over U.S. Patent No. 6,567,335 ("Norman et al."). Applicants respectfully submit that Norman et al. do not render unpatentable the present claims for the following reasons.

Claim 1 relates to a memory arrangement and recites, *inter alia*, that the memory arrangement includes a first buffer memory and a second buffer memory. Claim 1 recites that in the case of a command access, at least one command following an access command is written to the first buffer memory, and that in the case of a data access, at least one datum following accessed datum is written to the second buffer memory. Claim 1 also recites that that the at least one command following the accessed command and the at least one datum following the accessed datum are written independently of one another.

It is submitted that Norman et al. do not disclose, or even suggest, writing at least one command following an accessed command and at least one datum following an accessed datum independently of one another. Norman et al. disclose that when a special TAG is present on a TAG bus (40), a respective output on a data bus (42) is generated. Thus, the "commands" on bus (40) directly control the data flow as to address mapping and memory control, and thus are not written independently of one another. For instance, on col. 6, lines 15-22, it is stated that when a TAG (19h) is present on the TAG bus (40), data is read out of the device, and when a TAG (1a) is on the TAG bus (40), the contents of a control register are read out of the device. Thus, these commands control data flow. Furthermore, the input enable IEN, which connects buffers (48) and (52) shows that the buffers are not independent of each other. Taken as a whole, in contrast to the claimed subject matter, Norman et al. disclose a conventional memory control strategy, in which if there is a jump command, associated data is written, so that the writing of data is not independent of the command. In particular, if a special TAG is provided, a corresponding reaction in buffer (52) is established.

The arrangement claim may provide certain advantages over the conventional strategy in that there is no wait time needed between commands and corresponding data or

vice versa because they are written independently of each other and stored automatically. Thus, the arrangement claim may provide a time saving and an increase of memory performance which is not disclosed or suggested by Norman et al. since they rely on a dependence between the two buffers. See also, Norman et al, col. 6, lines 47 to 51 (indicating that data received on bus (42) is also used in conjunction with various commands present on the TAG bus (40) for performing various memory control functions).

For at least these reasons, it is respectfully submitted that Norman et al. do not render unpatentable claim 1, or claims 2 to 4, which depend from claim 1.

Claim 5 relates to a method for performing at least one of command access and data access during a program execution in connection with a programmable memory. Claim 5 recites that the method includes the steps of: recognizing in the case of a command access that a command access is present; recognizing in the case of a data access that a data access is present; writing a command following the accessed command to a first buffer memory; and writing a datum following the accessed datum to a second buffer memory; and that the command and the datum are written in the writing steps independently of one another.

As more fully set forth above with respect to claim 1, it is respectfully submitted that Norman et al. do not disclose, or even suggest, that a command and a datum are written in writing steps independently of one another, and that Norman et al. therefore do not render unpatentable claim 5, or claims 6 to 8, which ultimately depend from claim 5.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, it is respectfully submitted that Norman et al. do not disclose, or even suggest, all of the features recited in claim 1 or claim 5.. It is therefore respectfully submitted that Norman et al. do not render unpatentable claim 1 or claim 5.

Moreover, it is respectfully submitted that the cases of *In re Fine*, *supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects, at best, a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

*In re Fine*, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

*In re Jones*, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case

here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

*In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

It is accordingly submitted that claims 1-8 are patentable over Norman et al.

### III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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